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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,539	07/16/2003	Manfred Ostertag	14066-024001 / 2003P00076	8440
32864	7590	06/20/2005	EXAMINER	
FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			LIN, WEN TAI	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,539

Applicant(s)

OSTERTAG ET AL.

Examiner

Wen-Tai Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-111 is/are pending in the application.
4a) Of the above claim(s) 76-111 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-75 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-75 are presented for examination. Claims 76-111 have been canceled.
2. Claims 43, 55 and 67 are objected to because the term "the extracted target group" appears to lack antecedent basis.
3. Claims 5, 18, 31, 44, 56 and 68 are objected to because of the following issues:
 - (i) As to claims 5, 18, 31, 44, 56 and 68, it is unclear what constitutes the "enterprise resource planning system"? Since the specification does not specifically specify that it is a proprietary system, it is construed as any planning system a company might have for purpose of prior art rejection in this office action.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 6-17, 19-30, 32-43, 45-55, 57-67 and 69-75 are rejected under 35 U.S.C. 102(e) as being anticipated by Olivier [U.S. Pat. No. 6480885].

6. As to claim 1, Olivier teaches the invention as claimed including: a method of mining human capital information, the method comprising:

defining one or more attributes of a communication group[col.3, lines 35-41; col.26, lines 44-50];

extracting a target group by searching one or more of explicit and implicit data sources according to the defined attributes [col.26, lines 51-54; col.16, lines 56-66; i.e., implicit attributes are specified in an email requiring additional processing, which are indirectly obtained];

communicating with the extracted target group [col.26, lines 61-65]; and logging at least some of the communications; and analyzing the logged communications [col.3, lines 23-32 and 57-60].

7. As to claim 2, Olivier further teaches saving the defined attributes [i.e., the attributes forming each group must be saved otherwise the match servers of Fig.7 would not know what to match].

8. As to claim 3, Olivier further teaches communicating with the extracted target group includes sending to the target group an information request based on at least one of a survey and a questionnaire [e.g., in response to an email of Figs. 8-9].

9. As to claim 4, Olivier further teaches generating a report based on a result of analyzing the logged communications [e.g., col.3, lines 57-60; i.e., report on each subject as individualized archive].

10. As to claim 6, Olivier further teaches sending information to a member of the target group triggered on an occurrence of a life or work event associated with a member [see the example of Fig.8].

11. As to claim 7, Olivier further teaches defining attributes includes defining attributes based on at least one of special knowledge area, work experience, academic experience, position, and work situation associated with the target group [col.17, lines 7-14; col.18, lines 5-17].

12. As to claim 8, Olivier further teaches communicating occurs over at least one of a computer network, wireless, the Internet, an Intranet, electronic-mail and voice-mail [Abstract].

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13. As to claim 9, Olivier further teaches communicating includes sending to the target group at least one of structured communication [e.g., 524 of Fig.9 is structured communication] wherein possible responses to queries are predefined and unstructured communication wherein possible responses to queries are not predefined [i.e., by default reply to question at 526 of Fig.9 (after satisfying matching criteria) is unstructured and not predefined].

14. As to claim 10, Olivier further teaches that communicating includes distributing information to the target group, and receiving feedback from the target group [Abstract].

15. As to claim 11, Olivier further teaches providing an enterprise with an ability to make decisions based on a result of analyzing the one or more logged communications [col.3, lines 57-60; col.17, lines 21-27; i.e., filtering uncorrelated material (including spam) is a decision making process based on what's in the archive].

16. As to claim 12, Olivier further teaches that searching explicit data sources include searching data sources having explicitly defined attribute information [e.g., col.9, lines 18-29; i.e., explicit data is entered as a user's profile through registration].

17. As to claim 13, Olivier further teaches that searching implicit data sources include searching data sources having implicitly defined attribute information [e.g.,

col.16, lines 56-66; i.e., attributes specified in an email requiring additional processing are thus indirectly obtained].

18. As to claims 14-17, 19-30 and 32-40, since the features of these claims can also be found in claims 1-4 and 6-13, they are rejected for the same reasons set forth in the rejection of claims 1-4 and 6-13 above.

19. As to claim 41-42, Olivier further teaches generating and updating a distribution list of the target group at the time information is exchanged with the target group [e.g., col.25, lines 1-11; col.23, lines 26-50; i.e., in a chat or game setting, updating the list is inherently required because members come and go]

20. As to claims 43, 45-55, 57-67 and 69-75, since the features of these claims can also be found in claims 14, 21, 23, 25-27, 29, 32-33, 35-36, 38-40 and 42, they are rejected for the same reasons set forth in the rejection of claims 14, 21, 23, 25-27, 29, 32-33, 35-36, 38-40 and 42 above.

21. Claims 1, 14, 27, 40, 52 and 64 are rejected under 35 U.S.C. 102(e) as being anticipated by KANEVSKY et al.[U.S. PGPub 20030088463].

22. As to claims 14, 27, 40, 52 and 64, KANEVSKY teaches the invention as claimed including: a method of mining human capital information, the method comprising:

defining one or more attributes of a communication group[Abstract];
extracting a target group by searching one or more of explicit and implicit data sources according to the defined attributes [e.g., paragraphs 9 and 12-13, wherein the classification data obtained out of current transaction data is explicit data source, while the relation data produced from the prior transactions is implicit data source];
communicating with the extracted target group [e.g., paragraph 16]; and
logging at least some of the communications; and analyzing the logged communications [paragraph 44].

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 5, 18, 31, 44, 56 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over KANEVSKY et al.(hereafter "KANEVSKY")[U.S. PGPub 20030088463], as applied to claim 1 above.

25. As to claims 5, 18, 31, 44, 56 and 68, KANEVSKY does not specifically teach accessing an enterprise resource planning system to extract a target group.

However, it is well known in the art that an enterprise resource planning system provides databases for various corporate information such as parts, products, financial/transaction activities, personnel information, etc.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that KANEVSKY could have extracted the target group (i.e., defining information associated with one or more attributes for a target group) of certain advertised products from the company's enterprise resource planning system because it is more efficient to use an existing database for the underlying advertisement optimization, rather than creating a new one.

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Dalby et al. [U.S. PGPub 20020057284];

Stirpe et al. [U.S. PGPub 20020087496];

Gullotta et al. [U.S. PGPub 20020156904];

Koelle et al. [U.S. PGPub 20030005098];

Rajan [U.S. PGPub 20050032518];

KANEVSKY et al. [U.S. PGPub 20030088463];

Greene et al. [U.S. PGPub 20030004774];

Afeyan et al. [U.S. PGPub 20040204957]; and

Gaito [U.S. PGPub 20030171942].

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27. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 days from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday (8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

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(703)872-9306 for official communications; and

(571)273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

June 16, 2005

Wen-Tai Lin
6/16/05